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K&L Gates LLP P.O. Box 1135 CHICAGO, IL 60690			MOSSER, ROBERT E	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREA HUGHS-BAIRD and
BRIAN D. SWIFT

Appeal 2009-004914
Application 10/086,014
Technology Center 3600

Decided: December 17, 2009

20 Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R.
21 MOHANTY, *Administrative Patent Judges*.
22 FETTING, *Administrative Patent Judge*.

DECISION ON APPEAL

1 STATEMENT OF THE CASE

2 Andrea Hughs-Baird and Brian D. Swift (Appellants) seek review under
3 35 U.S.C. § 134 (2002) of a final rejection of claims 1-5, 8, 18, and 20, the
4 only claims pending in the application on appeal.

5 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
6 (2002).

7 SUMMARY OF DECISION¹

8 We AFFIRM.

9 THE INVENTION

10 The Appellants invented a gaming device having an improved offer and
11 acceptance game (Specification 2:24-25).

12 An understanding of the invention can be derived from a reading of
13 exemplary claim 1, which is reproduced below [bracketed matter and some
14 paragraphing added].

15 1. A gaming device comprising:
16 [1] a game including:

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed July 20, 2007) and the Reply Brief ("Reply Br.," filed November 13, 2008), and the Examiner's Answer ("Ans.," mailed September 17, 2008), and Final Rejection ("Final Rej.," mailed October 13, 2006).

- (i) a plurality of offers, wherein said plurality of offers are payable to a player, and
- (ii) a plurality of player selectable masked selections; a display device; an input device; a memory device storing a plurality of instructions; and a processor adapted to communicate with the display device and the input device, said processor operable to execute instructions to operate with said display device and said input device, for each play of the game, to:
 - (a) directly and individually associate said offers with said selections, such that each offer is directly and individually associated with a separate one of the selections,
 - (b) enable the player to select one of said selections,
 - (c) reveal the offer directly and individually associated with the selected selection to the player,
 - (d) enable the player to accept or reject the revealed offer,
 - (e) repeat steps (a) to (d) at least once if said player rejects said revealed offer, wherein if the player rejects said revealed offer, for said repeat of step (a) said revealed offer is directly and individually reassigned with one of said masked selections for at least one subsequent selection by the player; and
 - (f) if the player accepts said revealed offer, pay said revealed offer to the player.

THE REJECTIONS²

The Examiner relies upon the following prior art:

Baerlocher et al. US 6,648,754 B2 Nov. 18, 2003

Claims 1-5, 8, 18, and 20 stand rejected under 35 U.S.C. § 102(e) as anticipated by Baerlocher.

ISSUES

The issue pertinent to this appeal is whether the Appellants have sustained the burden of showing that the Examiner erred in rejecting claims 1-5, 8, 18, and 20 under 35 U.S.C. § 102(e) as anticipated by Baerlocher. This pertinent issue turns on whether Baerlocher describes that input selections and offers are directly and individually associated.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to the Prior Art

Baerlocher

01. Baerlocher is directed to a gaming device having and offer and acceptance game with a termination limit (Baerlocher 1:61-63).

² The Examiner's previously asserted 35 U.S.C. § 112, first paragraph, rejection has been withdrawn (Ans. 3).

1 02. Baerlocher describes a game where a player selects a first input
2 from a plurality of inputs (Baerlocher 9:9-13). The inputs are
3 associated with a number of steps (Baerlocher 9:9-11). The steps
4 are a numerical value from one up to the termination limit, such as
5 twenty-five (Fig. 4A and 4B). The steps are associated with an
6 offer and the offer is presented to the player after selecting an
7 input (Baerlocher 9:11-13). The player can either accept the offer
8 and the game terminates or the player can reject the offer and
9 select second input (Baerlocher 6:51-53 and 9:15-19). The steps
10 associated with second input are summed with the steps associated
11 with first input (Baerlocher 9:15-19). The offer associated with
12 the summed steps is presented the player (Baerlocher 9:15-22).
13 These steps are repeated until player exceeds a termination limit
14 of twenty-five steps or when the player accepts the offer
15 (Baerlocher 6:51-53 and 9:22-27).

16 03. The game can also be configured such that the player can pick
17 the same input selections two or more times and can further be
18 configured such that the same number of steps to be generated
19 whether or not the player picks the same input selections a
20 plurality of time (Baerlocher 10:39-44). The game can further
21 reshuffle or redistribute the numbers of step numbers associated
22 with the input selections after each offer and thereby provide a
23 new order of steps associated to all of the input selections
24 (Baerlocher 10:35-39).

1 04. When a player selects an input selection, the game reveals the
2 accrued steps and further displays the initial offer in the current
3 offer display (Baerlocher 9:38-49).

4 *Facts Related To The Level Of Skill In The Art*

5 05. Neither the Examiner nor the Appellants have addressed the
6 level of ordinary skill in the pertinent art of gaming systems and
7 devices. We will therefore consider the cited prior art as
8 representative of the level of ordinary skill in the art. *See Okajima*
9 *v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he
10 absence of specific findings on the level of skill in the art does not
11 give rise to reversible error ‘where the prior art itself reflects an
12 appropriate level and a need for testimony is not shown’”)
13 (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755
14 F.2d 158, 163 (Fed. Cir. 1985).

15 *Facts Related To Secondary Considerations*

16 06. There is no evidence on record of secondary considerations of
17 non-obviousness for our consideration.

18 **PRINCIPLES OF LAW**

19 *Claim Construction*

20 During examination of a patent application, pending claims are
21 given their broadest reasonable construction consistent with the
22 specification. *In re Prater* , 415 F.2d 1393, 1404-05 (CCPA 1969);
23 Limitations appearing in the specification but not recited in the claim are
24 not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364,

1 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the
2 specification” without importing limitations from the specification into the
3 claims unnecessarily). *See also Tex. Digital*, 308 F.3d 1200, 1204-05.

4 Although a patent applicant is entitled to be his or her own lexicographer
5 of patent claim terms, in *ex parte* prosecution it must be within limits. *In re*
6 *Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing
7 such definitions in the specification with sufficient clarity to provide a
8 person of ordinary skill in the art with clear and precise notice of the
9 meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480
10 (Fed. Cir. 1994) (although an inventor is free to define the specific terms
11 used to describe the invention, this must be done with reasonable clarity,
12 deliberateness, and precision; where an inventor chooses to give terms
13 uncommon meanings, the inventor must set out any uncommon definition in
14 some manner within the patent disclosure so as to give one of ordinary skill
15 in the art notice of the change).

16 *Anticipation*

17 "A claim is anticipated only if each and every element as set forth in the
18 claim is found, either expressly or inherently described, in a single prior art
19 reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628,
20 631 (Fed. Cir. 1987). "When a claim covers several structures or
21 compositions, either generically or as alternatives, the claim is deemed
22 anticipated if any of the structures or compositions within the scope of the
23 claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed.
24 Cir. 2001). "The identical invention must be shown in as complete detail as
25 is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d

1 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by
2 the claim, but this is not an *ipsissimis verbis* test, *i.e.*, identity of terminology
3 is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

4 ANALYSIS

5 *Claims 1-5, 8, 18, and 20 under 35 U.S.C. § 102(e) as anticipated by*
6 *Baerlocher*

7 The Appellants first contend that (1) Baerlocher does not directly or
8 individually associate offers with the selections such that each offer is
9 directly and individually associated with a separate one of the selections, as
10 required by limitation [5](a) of claim 1 (App. Br. 21-22 and 25-28). We
11 disagree with the Appellants. The Appellants contest the Examiner's
12 construction of limitation [5] (a) (Reply Br. 12-14 and Ans. 12-16) and
13 therefore we must construe this limitation under the broadest reasonable
14 interpretation. Limitation [5] (a) requires a direct and individual association
15 between an input selection and an offer. The Appellants are correct in their
16 assertion that the plain meaning for the term "directly", that is consistent
17 with their usage in the specification and the claims, is to be without
18 intervening or altering steps (Reply Br. 12-13). Under the broadest
19 reasonable interpretation, there must be a relationship between the offer
20 value and the input selection that will not be affected by other factors. The
21 plain and ordinary meaning of the term "individually" is a separate and
22 distinct element. As such, limitation [5] (a) requires that the relationship
23 between an input selection and an offer is independent of any other
24 relationship between other input selections and offers. The claim language

- 1 does not impose any further limitations on the direct and individual
- 2 relationship between the input selection and the offer value.

3 Baerlocher describes that a user selects an input device that is associated
4 to a step number and the step number is associated with an offer (FF 02).
5 For example, a player can select the first of a plurality of buttons and that
6 selected button is associated with the step number 5. Step number five is
7 further associated with an offer of 20. That is, there is a direct relationship
8 between the input selection and the offer. The value of the offer is directly
9 dependant on the input selected by the player. Additionally, the connection
10 starting from the input selection and ending with the offer value is an
11 individual one. That is, the resulting steps and values are only associated
12 with the specific input selection. Furthermore, we agree with the Appellants
13 that each input selection results in a separate offer (Reply Br. 11). As such,
14 Baerlocher describes limitation [5] (a).

15 The Appellants also contend that if the player rejects the offer, that offer
16 is not directly and individually reassociated with one of the input devices
17 (App. Br. 22). We disagree with the Appellants. Baerlocher explicitly
18 describes that the game can reassociate the step numbers and offer values
19 with the input selection thereby enabling a player to select the same
20 selection multiple times (FF 03). The game further allows for the
21 reshuffling or redistributing the step numbers to all of the input selections
22 after a player has rejected an offer (FF 03). This reassociation is direct and
23 individual for the reasons discussed *supra*. As such, Baerlocher explicitly
24 describes this limitation.

1 The Appellants further contend that (2) Baerlocher fails to describe the
2 feature of revealing the offer directly and individually associated with the
3 selected selection to the player, as required by limitation [5](c) (App. Br. 23-
4 24). We disagree with the Appellants. Baerlocher explicitly describes that
5 the current offer is revealed and displayed for the player to view upon the
6 player selecting an input selection. The input selection is directly and
7 individually associated to the offer values for the reasons discussed *supra*.
8 As such, Baerlocher describes limitation [5] (c).

9 The Appellants have not sustained the burden of showing that the
10 Examiner erred in rejecting claims 1-5, 8, 18, and 20 under 35 U.S.C.
11 § 102(e) as anticipated by Baerlocher.

CONCLUSIONS OF LAW

14 The Appellants have not sustained the burden of showing that the
15 Examiner erred in rejecting claims 1-5, 8, 18, and 20 under 35 U.S.C.
16 § 102(e) as anticipated by Baerlocher.

DECISION

19 To summarize, our decision is as follows

20 • The rejection of claims 1-5, 8, 18, and 20 under 35 U.S.C. § 102(e) as
21 anticipated by Baerlocher is sustained.

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1 No time period for taking any subsequent action in connection with this
2 appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

3

AFFIRMED

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8 mev

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